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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/540,997

06/28/2005

Cheol-Su Lee

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NOTARO, MICHALOS & ZACCARIA P.C.  
100 DUTCH HILL ROAD  
ORANGEBURG, NY 10962

EXAMINER

FISHER, PAUL R

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/540,997	<b>Applicant(s)</b> LEE, CHEOL-SU	
	<b>Examiner</b> PAUL FISHER	<b>Art Unit</b> 3689	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 23 March 2010.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 June 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)         | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)         | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. Request for Continued Examination submitted on March 23, 2010 has been acknowledged. Claims 2-5 have been canceled. Claim 1, is currently pending and has been considered below.

#### ***Continued Examination Under 37 CFR 1.114***

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on March 23, 2010 has been entered.

#### ***Claim Rejections - 35 USC § 101***

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claim 1 is rejected under 35 U.S.C. 101 as being directed to non-statutory subject matter. Based upon consideration of all of the relevant factors with respect to the claims as a whole, claim 1 is held to claim an abstract idea, and are therefore rejected as ineligible subject matter under 35 U.S.C. 101. The rationale for this finding is explained below:

Based on Supreme Court precedent and recent Federal Circuit decisions, the Office's guidance to an examiner is that one clue to patent eligibility under 35 USC 101

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is whether or not the process is (1) be tied to a particular machine or apparatus or (2) transforms underlying subject matter (such as an article or materials) to a different state or thing. *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876).

The claim should recite the particular machine or apparatus to which it is tied, for example by identifying the machine or apparatus that accomplishes the method steps, or positively reciting the subject matter that is being transformed, for example by identifying the material that is being changed to a different state.

There are two corollaries to the machine-or-transformation test. First, a mere field-of-use limitation is generally insufficient to render an otherwise ineligible method claim patent-eligible. This means the machine or transformation must impose meaningful limits on the method claim's scope to pass the test. Second, insignificant extra-solution activity will not transform an unpatentable principle into a patentable process. This means reciting a specific machine or a particular transformation of a specific article in an insignificant step, such as data gathering or outputting, is not sufficient to pass the test.

Here, applicant's method steps fail the first prong of the new test because while there appears to be machines there is no significant tie to the limitations being performed. For example establishing, recording, transmitting, moving and canceling, are not directly being carried out by any specific machine. While recording takes place "using one of an audio tag, a visual tag and an RFID tag" it is not shown to be carried

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out by a machine, rather currently it can be read that these tags are merely being used by a human which records the information. The requesting creation and transmission again is “by means of the audio tag, the visual tag or the RFID tag” and while the RFID tag is considered to be a structural element it is carrying out the requesting directly rather the requesting can be carried out by a person using these tags. The creating the electronic certificate step says at the electronic-certificate creation server, this is not saying that the server performs the task but rather where the task is being performed, broadly read this could be a human creating the certificate at the server, using the server a tool to create the certificate. The step of transmitting is considered to be an insignificant extra-solution activity step as described above since it is merely data transfer. Displaying is also considered to be an insignificant extra-solution step as merely data output. The step of authenticating is currently not tied and could be performed with out the need of a machine. Storing information is an extra-solution activity as it is merely data storage. Currently the significant steps described above can be performed by a person and do not require a machine to perform them. The claims do not pass the first test of Bilski with respect to providing a tie to a particular machine.

Further, applicant’s method steps fail the second prong of the test because the claimed steps do not result in an article being transformed from one state to another. There is no transformation occurring in the claims for a physical object or substance or data that represents physical objects or substances.

The claims as recited are directed toward the abstract idea of producing servicing electronic certificates. As shown above there is not a significant tie to a particular

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machine to show that the involvement of the machines that constitutes a practical application of this concept. Therefore as stated above the machines which are recited are merely for insignificant steps and as such do not render the claim patent eligible under 35 USC 101.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**6. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Leung et al. (US 7,010,808 B1) hereafter Leung, in view of Thomas et al. (US 2002/0042920 A1) hereafter Thomas, further in view of Matsuda et al. (US 2004/0148260 A1) hereafter Matsuda.**

**As per claim 1**, Leung discloses a method for servicing an electronic certificate for goods of a big-name brand or genuine quality (Col. 11, lines 19-33; discloses that the license server contains a digital certificate or an electronic certificate for goods, who the goods are from is taken to be merely a title, specifically big-name or genuine quality is taken to mean of original source or trusted source), the method comprising the steps of:

establish both an identification code for the goods as well as a secret code for creating the electronic certificate, prior to one of a first purchase and a first distribution

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(Col. 6, lines 36-55 and Col. 9, lines 31-53; disclose that the method establishes both a identification code for the goods as well as a secret code for creating an electronic certificate or digital certificate. Col. 11, lines 19-33; discloses that the digital certificate or electronic certificate is created using the secret code which is the private key used in the encryption of the files);

recording the identification code along with the secret code for creating an electronic certificate (1) for the goods prior to one of a first distribution and first purchase, the secret code being configured to be first known at the first distribution or the first purchase (Col. 6, lines 36-55 and Col. 9, lines 31-53; disclose that the method records and uses both a identification code for the goods as well as a secret code for creating an electronic certificate or digital certificate. Col. 11, lines 19-33; discloses that the digital certificate or electronic certificate is created using the secret code which is the private key used in the encryption of the files. The secret code is configured to be known at the first distribution or first purchase as a means to decrypt the data);

requesting creation and transmission of an electronic certificate (1) for the goods by inputting the established and recorded identification code and secret code into an electronic-certificate creation server (10) at the time of the first distribution or the first purchase, said electronic certificate (1), and a management program as well as the identification code and secret code, and being constructed so that only one electronic certificate can be created per goods (Col. 10, lines 45-62; disclose that the license server creates and transmits the electronic certificate to the device corresponding to the identification code and the secret code which is public/private key pair. Col. 11, lines

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19-33; disclose that the digital certificate is sent. Col. 14, lines 42-56; disclose that the license contain a management program or a set of rules which dictate how the digital goods can be used such as a DRM or digital rights management. Col. 9, lines 20-30; discloses that packages are made for each good and they dwindle in the inventory management as they are assigned to users);

firstly creating the electronic certificate (1) for the goods at the electronic-certificate creation server (10) after confirming the identification code, when the request for genuine quality certificate is received (Col. 11, lines 19-33; disclose that the digital certificate is created and sent after the identification code and secret code are confirmed. Col. 18, lines 52-67; disclose that the system receives a quality check or a check to see if the source is a trusted party thus the certificate is generated and transmitted in response to this request);

transmitting the firstly created electronic certificate (1) to a client (50) of the first distributor or first purchaser through a wire/wireless network (40) (Col. 17, line 62 through Col. 18, line 67; discloses that the certificate is transmitted through the network to authenticate the source); and

wherein a list entry is stored in a database (30) of an authentication/management server (20) for the electronic certificate (1) and the goods at the time of creation and transmission of the electronic certificate (1) by the electronic-certificate creation server (10) (Col. 18, lines 52-67; discloses a list is maintained or stored of the authentication/management server in this case the license server for the electronic



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certificate and the goods at the time of creation and transmission to show which have been validated and which ones have failed);

the method further comprising the steps of:

transmitting results of the certification or authentication as for the electronic certificate (1) and/or information of the goods of the big-name brand or genuine quality when certification or authentication is requested from the client (50) through the authentication/management server (20) (Col. 18, lines 52-67; discloses that the certification or authentication is tested and the results are sent to the client. Col. 10, lines 45-62; discloses that the license is sent to the user. Col. 11, lines 19-33; discloses that along with the license a digital certificate is used thus the user is sent the results because they are granted the license or they are denied the license. Col. 24, line 38 through Col. 25, line 33; discloses that the system validates the various components thus providing results to the trustworthiness of the data and the user);

moving the electronic certificated to the client of the transferee together with transfer of the goods (Col. 10, lines 45-62; discloses that the licenses is moved to the user. Col. 11, lines 19-33; discloses that along with the license a digital certificate is used thus the user has received both. Col. 10, lines 1-15; discloses that the digital package which is sent to the user includes the content itself and the license); and

canceling the electronic certificate from the client of a transferor, so as to achieve a change in ownership of the goods of the big-name brand or genuine quality (Col. 9, lines 21-30; discloses that content server performs inventory management where packages are created for the content and the inventory dwindles as the content is

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transferred to the user, as such the information is canceled or cleared out from the content server upon change in ownership. Col. 10, lines 45-62; discloses that the licenses is moved to the user. Col. 11, lines 19-33; discloses that along with the license a digital certificate is used thus the user has received both. Col. 10, lines 1-15; discloses that the digital package which is sent to the user includes the content itself and the license).

Leung further discloses where multiple licenses can be purchased through a web page (Col. 19, lines 14-31; disclose that a web page can be used to link information to the license agreements).

Leung fails to explicitly disclose that the recording the identification code along with the secret code for creating an electronic certificate occurs through the use of one of an audio tag, a visual tag and an RFID tag. Further Leung fails to explicitly disclose that the audio tag, the visual tag or the RFID tag are used to request creation and transmission. Also that the electronic certificate comprises a character image which can be selected from among several shapes. And displaying the character image of the transmitted electronic certificate (1) on a display apparatus of the client (50) so that possession of the big-name brand or genuine quality can be shown, and authenticating the big-name brand or genuine quality can be achieved even without the step of authenticating the actual goods themselves, but by merely authenticating the electronic certificate;

Thomas, which talks about on-line media, teaches it is known to for website or web pages to contain links to purchase items (Page 10, paragraph [0112]; teaches that

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the user is presented with a link to purchase merchandise, from this it would have been obvious that the web page shown in Leung would contain links or visual tags which are used to request creation and transmission of information or data. Since the different licenses in Leung can be laid out on a web page similar to the one shown in Thomas it would have been obvious that the links could act as visual tags linking the identification code and secret code for the license and the digital certificate, thus when a user selects the type of license they want the license from the web site the request for the license is created and transmitted, thus creating the license and transmitting the license upon purchase by the user).

Therefore, from this teaching of Thomas, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method of servicing electronic or digital certificates provided by Leung, with the use of a visual tag to link the information on a web page as taught by Thomas, since the different licenses in Leung can be laid out on a web page similar to the one shown in Thomas it would have been obvious that the links could act as visual tags linking the identification code and secret code for the license and the digital certificate, thus when a user selects the type of license they want the license from the web site the request for the license is created and transmitted, thus creating the license and transmitting the license upon purchase by the user.

Matsuda, which talks about detecting counterfeit products, teaches product information containing an image tag or character image, and displaying the character image of the transmitted electronic certificate (1) on a display apparatus of the client

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(50) so that possession of the big-name brand or genuine quality can be shown, and authenticating the big-name brand or genuine quality can be achieved even without the step of authenticating the actual goods themselves, but by merely authenticating the electronic certificate (Page 1, paragraph [0006]; teaches it is known to use images to determine if a product is genuine, it is shown that the image is displayed to a client or salesperson can compare the tag image with the tag of an actual product to determine the authenticity of the product, thus with out authenticating the actual goods, the goods can be authenticated by using this image tag. It would have been obvious to implement such a method in Leung so the customer is assured they are receiving the license agreement from a company authorized to provide it, by displaying the image the user is able to authenticate the goods and ensure they are receiving the product they desire. The shape of the image obviously can come in different sizes and shapes since it would have to be different for every product).

Therefore, from this teaching of Matsuda, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method of servicing electronic or digital certificates provided by the combination of Leung and Thomas, with the use of images to authenticate goods as taught by Matsuda, so the customer is assured they are receiving the license agreement from a company authorized to provide it, by displaying the image the user is able to authenticate the goods and ensure they are receiving the product they desire. The shape of the image obviously can come in different sizes and shapes since it would have to be different for every product.

***Response to Arguments***

7. Applicant's arguments filed March 23, 2010 have been fully considered but they are not persuasive.
8. Applicant's arguments with respect to claim 1 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to PAUL FISHER whose telephone number is (571)270-5097. The examiner can normally be reached on Mon/Fri [8am/4:30pm].

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janice Mooneyham can be reached on (571) 272-6805. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/P. R. F./  
Examiner, Art Unit 3689  
/Dennis Ruhl/  
Primary Examiner, Art Unit 3689